

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue Application	)	
of U. S. Patent No. 5,872,229	)	
	)	
Inventors: Jih-Hua Liu <i>et al.</i>	)	
	)	
Applicants: Abbott Laboratories	)	Group Art Unit:
	)	TBA
Granted: February 16, 1999	)	
	)	
Reissue Serial Number:	)	
TBA	)	
	)	Examiner:
For: Process for 6-O-Alkylation of	)	TBA
Erythromycin Derivatives	)	

**REISSUE DECLARATION UNDER  
37 C.F.R. §1.175 AND POWER OF ATTORNEY**

Mailstop Reissue  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

I hereby declare that:

- The residence, post office address, and citizenship of the inventor is stated

below:

<b>Send Correspondence to:</b> <b>Customer Number 23723</b>  Attention: IP Docketing Patterson, Belknap, Webb & Tyler, LLP 1133 Avenue of the Americas New York, New York 10036			<b>Direct Telephone Calls to:</b> <small>(name and telephone number)</small>  Stuart E. Pollack (212) 336-2721	
1	FULL NAME OF INVENTOR	FAMILY NAME Liu	FIRST GIVEN NAME Jih-Hua	SECOND GIVEN NAME
	RESIDENCE & CITIZENSHIP	CITY Green Oaks	STATE OR FOREIGN COUNTRY Illinois	COUNTRY OF CITIZENSHIP United States

	POST OFFICE ADDRESS	POST OFFICE ADDRESS 31645 Rein Court	CITY Green Oaks	STATE & ZIP CODE/COUNTRY IL 60048/United States
2	FULL NAME OF INVENTOR	FAMILY NAME Foster, Jr.	FIRST GIVEN NAME George	SECOND GIVEN NAME A.
	RESIDENCE & CITIZENSHIP	CITY Minden	STATE OR FOREIGN COUNTRY Nevada	COUNTRY OF CITIZENSHIP United States
	POST OFFICE ADDRESS	POST OFFICE ADDRESS 1782 Lantana Drive	CITY Minden	STATE & ZIP CODE/COUNTRY IL 89423-5169/United States
3	FULL NAME OF INVENTOR	FAMILY NAME Montgomery	FIRST GIVEN NAME Stephen	SECOND GIVEN NAME H.
	RESIDENCE & CITIZENSHIP	CITY Vernon Hills	STATE OR FOREIGN COUNTRY Illinois	COUNTRY OF CITIZENSHIP United States
	POST OFFICE ADDRESS	POST OFFICE ADDRESS 302 Angela Court	CITY Vernon Hills	STATE & ZIP CODE/COUNTRY IL 60061/United States

2. I am authorized to act on behalf of **Abbott Laboratories**, and the title of my position with said assignee is Senior Vice President and General Counsel.

3. The entire title to U.S. Patent No. 5,872,229 is vested in Abbott Laboratories.

4. I believe said inventors are the original, first and sole inventors of the subject matter described and claimed in U.S. Patent No. 5,872,229 (original patent) granted on February 16, 1999, and for which a reissue patent is sought on the invention entitled: PROCESS FOR 6-O-ALKYLATION OF ERYTHROMYCIN DERIVATIVES, the specification of which:

☒ [X] is attached hereto.

☐ [ ] was filed on \_\_\_\_\_ as reissue application no. \_\_\_\_\_ and was amended on \_\_\_\_\_.

5. I do not know and do not believe that this invention was ever known or used in the United States before our invention thereof; and to the best of our knowledge and belief, said invention was not in public use or on sale in the United States more than one (1) year prior to our application or patented or made the subject of an inventor's certificate or described in any printed publication in any country before our invention or more than one (1) year prior to our application or patented in any foreign country.

6. I have reviewed and understand the contents of the specification and claims of the reissue application as amended by a Preliminary Amendment.

7. I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

PRIOR FOREIGN/PCT APPLICATION(S) AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. 119:				
COUNTRY (if PCT, indicate "PCT")	APPLICATION NUMBER	DATE OF FILING (day, month, year)	PRIORITY CLAIMED UNDER 35 USC 119	
none claimed			YES	<input checked="" type="checkbox"/> NO
			YES	NO
			YES	NO
			YES	NO
			YES	NO

8. I acknowledge the duty to disclose all information to the United States Patent Office known to us to be material to the examination of the reissue application, in accordance with 37 C.F.R. § 1.56.

9. I believe the original patent, upon which the reissue application is based, is partly inoperative by reason of our having claimed less than we had a right to claim therein, in that we had a right to claim our invention more specifically; and more particularly by us having omitted therefrom narrower claims than the scope of the original claims 1-7.

10. Claims 1-7 of the original patent claimed certain novel intermediate steps that may be used, among other things, in the synthesis of 6-O-alkylerythromycin compounds. Further steps to obtain the typically-desired final compounds—6-O-alkylerythromycin compounds—are described in detail in the patent, including for example in column 1, lines 45-58.

11. The new process claims proposed in the Preliminary Amendment are narrower in scope than claims 1-7, and cover among other things processes that afford 6-O-methylerythromycin A, including the additional steps required to convert novel intermediates into 6-O-methylerythromycin A.

12. The particular features of our invention as set forth in new claims 8-14 are narrower in scope than the existing claims of the original patent. In order to provide the complete range of protection to which we are entitled, and which we had desired to obtain in our original application that matured into U.S. Patent No. 5,872,229, it is desirable to have claims of the scope of claims 8-14.

13. The error of claiming less than we had a right to claim arose without deceptive intent on our part.

14. In view of the foregoing, U.S. Patent No. 5,872,229 should be reissued with the claims now presented or with claims commensurate therewith.

15. Wherefore, the undersigned requests a reissue patent as herein sought for the purpose of adequately, clearly, and fully protecting the disclosed invention to which we are entitled.

16. We hereby appoint Practitioners at Customer Number 23723, Patterson, Belknap, Webb & Tyler LLP, as our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

17. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therein.

Date: 3-18-04

By: Jose M. de Lasa  
Jose M. de Lasa  
Senior Vice President and  
General Counsel  
AP6D-2, Dept. 0364  
Abbott Laboratories  
100 Abbott Park Road  
Abbott Park, Illinois 60064

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Erythromycin Derivatives	)	

## ASSENT OF ASSIGNEE TO REISSUE

Mailstop Reissue  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The undersigned, by authority vested in him by Abbott Laboratories, assignee of the entire interest in U.S. Patent No. 5,872,229, the invention described therein, and in any reissue thereof by assignment recorded at Reel 007799, Frame 0189, hereby assents on behalf of the assignee to the accompanying application for reissue.

Date: 3-16-04

By: Jose M. de Lasa

Jose M. de Lasa  
Senior Vice President and General Counsel  
AP6D-2, Dept. 0364  
Abbott Laboratories  
100 Abbott Park Road  
Abbott Park, Illinois 60064

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**CERTIFICATE UNDER 37 C.F.R. 3.73(b)**

Mailstop Reissue  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Abbott Laboratories, a corporation in Abbott Park, Illinois, certifies that it is the assignee of the entire interest in U.S. Patent No. 5,872,229, by virtue of the chain of title from the inventor to the assignee as shown below:

FROM	TO	REEL/FRAME NO. or Documents Enclosed
Jih-Hua Liu George A. Foster, Jr. Stephen H. Montgomery	Abbott Laboratories	007799/0189

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued therein.

Respectfully submitted,

Date: 3-16-04

By: Jose M. de Lasa

Jose M. de Lasa  
Senior Vice President and General Counsel  
AP6D-2, Dept. 0364  
Abbott Laboratories  
100 Abbott Park Road  
Abbott Park, Illinois 60064